

Application Serial No.: 10/706,521
Attorney Docket No.: 2C06.1-010
PATENT

REMARKS

The Office Action mailed November 17, 2004 has been received and reviewed. By the present Response and Amendment, Claims 1 and 8 are amended. No new matter has been introduced.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses, as one of ordinary skill in the art would consider that the use of the word "permanently" is at least inherently supported by the written description. For example, Paragraphs 0024, 0027 and 0030 would reasonably convey to one skilled in the art that applicant was in possession of the claimed invention as of the filing date. The specified application methods of "dying, printing, heat-transfer or sublimation, embroidery . . .", would be understood by a skilled artisan to product a permanent image. Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (exact language not required in order to satisfy written description requirement). Nevertheless, Claims 1 and 8 are amended to address this grounds of rejection by reciting the provision of a mask including "at least one display originally visible...". From the above-referenced paragraphs, one skilled in the art would understand that applicant was in possession of the claimed invention as of the filing date. In particular, the specification teaches that the at least one display can be placed on the material of the mask (Paragraph 0024, lines 22-26; Paragraph 0027, lines 21-23; FIGS 1-12) and may be affixed to the mask by a variety of ways including: dying, printing, heat transfer or sublimation, embroidery, or any suitable application method (Paragraph 0030, lines 6-8). Therefore, the §112 rejection is believed to be addressed and overcome.

Claims 1-11 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,488,547 to Mason, in view of U.S. Patent No. 5,582,187 to Hussey. Applicant respectfully traverses this grounds of rejection. As a threshold matter, Hussey does not disclose a mask having any display visible thereon. The mouth and tongue shown in Fig. 1 of Hussey are the actual mouth and tongue of the user, seen through the transparent panel of the mask. This is readily apparent by noting the continuous lines of the wearer's chin and cheek, shown in the drawing figure underneath the mask, and extending continuously

Application Serial No.: 10/706,521
Attorney Docket No.: 2C06.1-010
PATENT

beyond the mask. Also, Hussey describes that "FIG. 1 shows the protective mask in place on the face of the wearer with mouth open." (Emphasis added). Thus, neither Mason nor Hussey disclose or suggest any display originally visible on the mask, as presently claimed. Accordingly, even if the references were combined in the manner suggested by the Examiner, applicant's presently claimed invention still would not be disclosed or suggested by the purported combination.

Moreover, one of ordinary skill in the art would not have sufficient motivation to combine the references as suggested by the Examiner. The display of Mason '547 comprises an "anhydrous hygroscopic layer," that is initially not visible on the mask, and only becomes visible by means of a coloration change after the absorption of a sufficient quantity of moisture from the wearer's breath. See Mason '547, Column 2, lines 49-55. By contrast, the at least one display appearing on Applicant's mask is originally visible and is a fixed feature of the mask. Additionally, it is further noted with regard to Claim 8, that the method of the present invention includes "providing information regarding specified characteristics of the wearer in the at least one display of the mask." In its intended method of use, the display of Mason '547 does not provide information about the wearer, but instead provides information about the mask (i.e. that the mask may be contaminated due to extended use). See Mason '547, Column 1, lines 36-41. Hussey '187 is a substantially non-permeable membrane used to cover the mouth of a wearer engaging in oral sex. See Hussey '187, Column 7, lines 30-44; Column 9, lines 58-62. The protective shield disclosed in Hussey '187 does not include any display, but rather is formed of a transparent membrane. Therefore, since Hussey '187 does not teach or disclose the use of any display in conjunction with a protective mask, it would not have been obvious to modify Mason's invention with Hussey's to achieve Applicant's claimed invention.

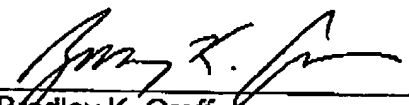
Accordingly, it is respectfully submitted that all grounds of rejection have been overcome.

Application Serial No.: 10/706,521
Attorney Docket No.: 2C05.1-010
PATENT

CONCLUSION

In view of the amendments submitted herein and the above comments, it is believed that all grounds of rejection are overcome and that the application has now been placed in full condition for allowance. Accordingly, Applicant earnestly solicits early and favorable action. Should there be any further questions or reservations, the Examiner is urged to telephone Applicant's undersigned attorney at (770) 984-2300.

Respectfully submitted,


Bradley K. Groff
Reg. No. 39,695

GARDNER GROFF, P.C.
100 Parkwood Point
2018 Powers Ferry Road
Suite 800
Atlanta, Georgia 30339
Tel: 770/984-2300
Fax: 770/984-0098

W:\Client Files\2003\2003-09-08-Cater, Cori\2C05.1-010 - Reexamination\2003-09-08 (Response After Final) Letter